

**REMARKS**

Claims 1, 3-6, and 8-22 are pending. In the previous response, Applicants elected species drawn to "the area enveloped by a coupling mechanism where an extension is knurled," on which claims 1, 3-6, 14, 15, and 21 were believed to read. Claims 8-13, 16-20, and 22 have been presently withdrawn from consideration by the Examiner. Claims 1, 3-6, 14, 15, and 21 have been rejected. Claim 14 has been presently cancelled. Applicants' representative would like to thank the Examiner for the courtesy of a telephone interview on September 7, 2006. In view of the discussion below, Applicants now believe that the application is in condition for allowance.

**Claim Objections**

The Examiner has objected to claim 14 as being dependent on a non-elected claim. Applicants have cancelled claim 14, thereby rendering this objection moot.

**Claim Rejections 35 U.S.C. § 102**

The Examiner has rejected claims 1, 3-6, 14, 15, and 21 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,662,612, issued to Niehoff. In particular, the Examiner states that Figure 1A of Niehoff discloses "a syringe comprising a barrel (10) comprising a conical front wall and a discharge tip; a plunger (12) having a forwardly facing surface of a slope conforming to the conical front wall; and a knurled extension member (14) not extending outside the barrel in at least one position adapted to be enveloped by a coupling mechanism (18) (column 1, lines 62-65), wherein the

knurls are oriented transversely to and about a longitudinal axis and the extension is free of aperture extending therethrough." In relevant part, as it pertains to this response, the Examiner suggests that Niehoff teaches a "knurled extension member." Applicants respectfully disagree.

As an initial matter, each of independent claims 1, 15, and 21 includes a limitation to a knurled extension. In particular, independent claim 1 recites that the "rearward facing extension is knurled," and that the knurls are "a series of ridges or grooves that are not adapted to interlockingly engage with said coupling mechanism." Both of independent claims 15 and 21 recite that the extension comprises "a plurality of knurls." As will be discussed below in greater detail, Niehoff does not teach a knurled extension, and there is no reason why one would modify the extension of Niehoff to include knurls. Further, even if one were to assume that Niehoff teaches a knurled extension (which Applicants believe one cannot), Niehoff, at most, would teach one knurl, and there would be no motivation to add additional knurls.

Fig. 1A of Niehoff does show an extension (14) on a syringe plunger (12). However, that extension is not knurled. Rather, it only shows a mushroom-shaped button (having a stem and a cap), which is the very art Applicants describe as problematic in the Background section of the present application, and which Applicants move away from with the claimed invention. As discussed above, the knurls are a series of ridges or grooves on the extension. Additionally, a series of ridges or grooves is the common, ordinary meaning of "knurled." For example, the 2006 edition of the

Random House Unabridged Dictionary lists a definition of "knurled" as "having small ridges on the edge or surface." (See [www.dictionary.reference.com](http://www.dictionary.reference.com)) There are no such ridges shown in Niehoff and thus there are no knurls shown in Niehoff. Further, the word "knurl" does not appear in Niehoff. As such, Applicants submit that independent claims 1, 15, and 21 (and any claims dependent thereon) are not anticipated by Niehoff.

Further, one skilled in the art would not be motivated to add knurls to the extension shown in Niehoff. There is no need for such knurls in the apparatus of Niehoff because the jaws (18) of Niehoff already surround the "cap" end of the extension member (14) to provide connection between those two components. Why would one be motivated to add an extra and detailed step of manufacture to the extension of Niehoff simply to provide such an unnecessary feature?

The above was discussed with the Examiner, and the Examiner then suggested that the cap portion of the extension of Niehoff is of a larger transverse cross-section than the stem of the extension, and therefore could be considered a knurl. Applicants disagree, as that is divergent from the ordinary meaning, as discussed above. However, even if one skilled in the art were to consider the "cap" to be a knurl (which Applicants submit one would not), there is only one cap, and thus only one knurl in Niehoff, whereas the independent claims of the present application recite "knurls" or "a plurality of knurls" (emphasis added). And, the cap cannot be a plurality of knurls because it includes both a proximal side and a distal side (each side being a

ridge, and therefore a knurl). A ridge includes both a proximal side and a distal side. One cannot have a ridge having only a proximal side without any distal side, or vice versa. The two sides serve to define a single ridge. Thus, Neihoff only shows one ridge, and thus one knurl, as opposed to the knurls of the present claims. Thus, again Applicants submit that independent claims 1, 15, and 21 (and any claims dependent thereon) are not anticipated by Niehoff. Further, one skilled in the art would not be motivated to add a second cap to the extension of Niehoff to provide a plurality of knurls, because to do so would result in an unnecessary modification of Niehoff. As described above, the jaws of Niehoff already provide connection with the cap of the extension. Adding a second cap would add materials, add cost, and increase the length of the apparatus of Niehoff, all while doing nothing to improve function. Where would be the motivation to do that?

In view of the above, Applicants respectfully request a withdrawal of the rejection of claims 1, 3-6, 14, 15, and 21 under 35 U.S.C. § 102(b) as anticipated by Niehoff.

### **Conclusion**

For the foregoing reasons, it is submitted that all claims are patentable and a Notice of Allowance is respectfully requested.

No fee is believed due with this submission. However, if any additional fee or surcharges are deemed due, please charge same or credit any overpayment to Deposit Account No. 23-3000.

Application Serial No. 09/764,630  
Response dated September 11, 2006  
Reply to Office Action dated June 9, 2006

The Examiner is invited to contact the undersigned attorney with any  
questions or remaining issues.

Respectfully submitted,  
Wood, Herron & Evans, L.L.P.

By:David E. Jefferies/  
David E. Jefferies, Reg. No. 46,800

Wood, Herron & Evans, L.L.P.  
2700 Carew Tower  
Cincinnati, Ohio 45202  
(513) 241-2324 (telephone)  
(513) 241-6234 (facsimile)